

Remarks/Arguments

Claims 34-60 remain pending in this application. Withdrawal of prior rejections, noted on page 2, paragraph 2 of the present Office Action, are acknowledged with appreciation.

Applicants' representative notes that the power of attorney for this application has been narrowed to include only Amgen attorneys and a Revocation of Prior Power Of Attorney was filed with respect to the Finnegan, Henderson law firm. It is respectfully and earnestly requested that all future correspondence take into account this important change and that all future communications be mailed to the undersigned attorney at the address on the bottom of this response.

Claim Rejections – 35 U.S.C. § 101

Section 4a: Claims 34-60 are rejected under 35 U.S.C. § 101 as allegedly not supported by a specific or substantial asserted utility or a well established utility for the reasons discussed in the previous Office Action. Applicant's representative disagrees for the following reasons. At the outset, it is made clear that the following arguments do not in anyway concede that there is only the one utility discussed below.

The TIGIRR genetic locus is at chromosome 11p15.5, which is situated in the midst of a number of genetic disorders discussed in the specification and in various journal references (see, *e.g.*, Deng et. al. (1996) Science, vol. 274, 2057). These genetic disorders typically arise after undergoing substantial genetic rearrangements such as LOH in this region. The present invention provides a new and useful set of molecules, namely TIGIRR nucleic acids, that can be used in diagnostic or prognostic assays either on carrier DNA or for prenatal diagnosis of fetus DNA. Specifically, these assays would test for LOH in this region. The LOH that is detected does not depend on the specific association of TIGIRR with a disease, rather, the mere presence of LOH is indicative of a disease condition. Thus, it is respectfully submitted that the presently claimed nucleic acid sequences have at least one specific and substantial utility fully supported by the specification as filed and withdrawal of this rejection is requested.

Section 4b: Claims 34-60 are rejected under 35 U.S.C. §112 first paragraph for allegedly lacking a sufficient teaching to make and use the invention in view of the above described utility rejection, *i.e.*, one cannot teach how to use that which has no use. It is respectfully submitted that the above made arguments have overcome the utility rejection and accordingly, the rejection for failure to teach how to use the invention has been mooted.

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Amdt. dated February 12, 2004
Reply to Office action of August 12, 2003

The Office Action appears to have made the assumption that the only useful purpose for nucleic acids is to encode polypeptides, that this proteins to be useful must be involved in some kind of disease or condition, and further, that the polypeptides must be an IL-1R-like molecule that is functional.

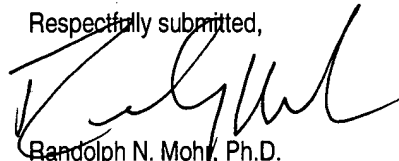
This is not correct. The specification provides utility for the nucleic acids that include use as diagnostic or prognostic markers. Thus, the TIGIRR nucleic acids do not need to be of a sequence that encodes a particular polypeptide having a particular function, rather, the nucleic acid need only hybridize to the proper genomic locus such that it can differentiate LOH from normal chromosomes in a disease prone region of the chromosome.

Thus, it is respectfully requested that this rejection be withdrawn.

CONCLUSION

Applicant respectfully submits that the application is in condition for allowance, and respectfully requests issuance of a notice of allowance. The Examiner is encouraged to telephone the undersigned in order to resolve any outstanding issues in the present application and to facilitate its prosecution.

Respectfully submitted,



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